

REMARKS

In the Office Action mailed April 16, 2010, the Examiner rejected Claims 1-10 and 36-40 under 35 U.S.C. §112(1) for lacking enablement, and rejected Claims 1-10 and 36-40 on the ground of non-statutory obviousness-type double patenting as being unpatentable over claims 1-4 of U.S. Patent No. 7,674,787 (hereinafter, “the ‘787 patent”). Each rejection is addressed below.

I. Rejection of Claims 1-10 and 36-40 under 35 U.S.C. §112(1)

The Examiner rejected Claims 1-10 and 36-40 for lacking enablement. In particular, the Examiner stated:

Claims 1-10, 36-40 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for making compounds and salts of the compounds of the given formula I, does not reasonably provide enablement for the corresponding prodrugs of the compounds of formula I. The claim(s) contains subject matter that was not described in the specification in such a way as to enable one skilled in the art of medicinal chemistry to use the invention.

The Examiner additionally stated, “Deletion of the term ‘prodrug’ from the claims would overcome the above rejection.

So as to expedite prosecution while not acquiescing with the Examiner’s arguments, the Applicants amend Claim 1 such that the term “prodrug” is no longer recited. The Applicants reserve the right to prosecute previously presented Claim 1, or similar claims, at a future date. In light of this amendment, the Applicants request withdrawal of this rejection.

II. Rejection of Claims 1-10 and 36-40 for Double Patenting

Claims 1-10 and 36-40 are rejected on the ground of nonstatutory obviousness-type double patentable over Claims 1-4 of U.S. Patent No. 7,674,787. The Applicants submit a Terminal Disclaimer against U.S. Patent No. 7,674,787 to obviate this rejection.

CONCLUSION

All grounds of rejections and objections of the Office Action mailed April 16, 2010 having been addressed, reconsideration of the application is respectfully requested. It is respectfully submitted that the invention as claimed fully meets all requirements for patentability and that the claims are worthy of allowance. Should the Examiner believe that a telephone interview would aid in the prosecution of this application, Applicants encourage the Examiner to call the undersigned collect at (608) 662-1277.

Respectfully submitted,

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